

REMARKS

It is respectfully requested that the present Request for Reconsideration be entered into the Official File in view of the fact that the Request for Reconsideration automatically places the application in condition for allowance. Thus, the present Request for Reconsideration is believed to be in proper form for placing the application in condition for allowance.

Alternatively, if the Examiner continues with the rejections of the present application, it is respectfully requested that the present Request for Reconsideration be entered for purposes of an Appeal.

Status of the Claims

Claims 1-12 are currently pending in the present application. Applicants respectfully submit that no claims are being amended, canceled or added in the reply herein. Thus, a listing of the claims is not necessary.

Applicants respectfully request the Examiner to reconsider the present application in view of the following remarks.

Issues Under 35 U.S.C. § 103(a)

There are various rejections cited by the Examiner under 35 U.S.C. § 103(a) as stated on pages 2-7 of the Office Action. In all three rejections, the primary reference is Obayashi *et al.* '989 (U.S. Patent No. 4,863,989) and a secondary reference is Hosokawa *et al.* '826 (U.S. Patent Application Publication No. 2001/0053826). Applicants respectfully traverse.

Distinctions over Cited Combinations

The present invention is directed to a water-absorbent resin composition having discoloration resistance comprising a water-absorbent resin, an oxygen-containing reducing inorganic salt, an aminocarboxylic acid-based metal chelating agent and an organic antioxidant (see pending claim 1). Other embodiments are recited in claims 2-12.

The primary reference of Obayashi '989 is cited against the pending claims as disclosing most claimed features except, e.g., the claimed aminocarboxylic acid-based metal chelating agent (see Office Action at, for example, page 3, lines 3-4). Of course, Hosokawa '826 is cited to account for such deficiencies of Obayashi '989. Also, Hosokawa '826 is cited as solving a different problem in the art and is thus combinable with Obayashi '989.

However, this is a major deficiency of the primary reference, and Applicants respectfully submit that the Examiner has not given proper consideration of the problems in the art and how the present invention has solved such problems. Applicants note that the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem(s) it solves. *In re Wright*, 848 F2d 1216, 6 USPQ2d 1959, 1962 (Fed. Cir. 1988) ("The problem solved by the invention is always relevant. The entirety of a claimed invention, including the combination viewed as a whole, the elements thereof, and the properties and purpose of the invention, must be considered"); *In re Spinnoble*, 160 USPQ 237 (CCPA 1969) ("discovery of the source of a problem" is part of the "subject matter as a whole" to be considered in determining obviousness).

As previously explained, one significant disadvantage with conventional compositions is that they cannot exhibit sufficient discoloration resistance (see page 2, line 24 to page 3, line 5 of

the present specification). Particularly, the water-absorbent resins used in an absorbent article has to avoid discoloration even when the absorbent articles are stored for a long period of time, and/or under severe high-temperature and high humidity conditions (see page 2, lines 20-23 of the present specification). A major feature of the water-absorbent resin composition of the present invention resides in that discoloration resistance is remarkably improved by incorporating the metal chelating agent. As even proven by the experimental results in the present specification, an absorbent article obtained by using the water-absorbent resin composition of the present invention, which contains an aminocarboxylic acid-based metal chelating agent, has excellent discoloration resistance even in a test with severe high-temperature, high-humidity environmental conditions.

It is respectfully submitted that by failing to disclose claimed aminocarboxylic acid-based metal chelating agent, Hosokawa '826 is improperly cited and combined with Obayashi '989. Applicants also maintain that Hosokawa '826 neither discloses nor suggests the effects of discoloration resistance of a superabsorbent resin before swelling under a high-temperature, high-humidity environment as previously mentioned.

Also, the Examiner refers to paragraph [0082] of Hosokawa '826 as the basis for its combination with the primary reference (see Office Action at, e.g., page 3, lines 14-15). However, a closer reading of paragraph [0082] reveals that Hosokawa '826 is merely describing the proper amounts of its chelating agent with respect to its own composition, and is not suggesting using its chelating agent *per se* to maintain gel stability or stability of a resin composition. For instance, it is not clear that component (B) of Hosokawa '826 or the amount of component (A) contributes to gel stability, or the actual combination thereof.

Thus, the instant rejections are improper. The application of hindsight is inappropriate where the prior art does not suggest that the claimed compound/composition could reasonably be expected to manifest the properties and advantages that were found for the claimed invention. *Sanofi-Synthelabo*, 89 USPQ2d 1370, 1379 (Fed. Cir. 2008) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 36 (cautioning against hindsight whereby the teachings of the invention are read into the prior art) and *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. ___, 1742 [550 U.S. 398, 82 USPQ2d 1385] (recognizing “hindsight bias” and “ex post reasoning” as inappropriate in determination of obviousness)). Such inappropriate hindsight has been applied for all outstanding rejections.

Since the present invention is not obvious in light of Obayashi ‘989, the combinations of Obayashi ‘989 and Hosokawa ‘826, as well as the combinations of Obayashi ‘989, Hosokawa ‘826 and the other cited secondary references, are improper. Therefore, Obayashi ‘989 and the above mentioned references have been improperly combined and cited against the present invention. Withdrawal of all rejections is respectfully requested.

Pages 7-8 of Office Action

In addition, in the outstanding Office Action at pages 7-8, the Examiner does not find previous arguments by Applicants as persuasive. But in explaining why the rejections are being maintained, the Examiner further cites Miyake ‘807 (U.S. 2001/0053807) as evidence. However, Miyake ‘807 is not a part of any of the rejections in the Office Action. Specifically, Miyake ‘807 is not mentioned in the three rejections stated on pages 2, 4, and 6 of the Office

Action. If anything, Torii '359 (US 2003/0069359) is cited as evidence for the rejection stated on page 4 of the Office Action. Thus, Examiner's assertions are not persuasive.

Furthermore, Applicants note that Miyake '807 should be read in its entirety. Particularly, Applicants note paragraphs [0146]-[0149] of Miyake '807, wherein it is disclosed that light resistance is exhibited by the amount of impurity (nitrilotriacetic acid) of a chelating agent, and not the chelating agent *per se* (see especially paragraph [0149]). This is an entirely different technical concept from the present invention. One of ordinary skill in the art would not have the proper rationale, including a proper rationale, to combine Obayashi '989 with Hosokawa '826 and then further with Miyake '807. If somehow the Obayashi '989 and Hosokawa '826 references are combined, or any of other cited references, the skilled artisan would not even acknowledge any benefit of discoloration resistance imparted by a metal chelator based on the disclosure of Miyake '807. Controlling the amount of nitrilotriacetic acid is not the same as what is being claimed.

Also, in the "*Response to Arguments*" section of the Office Action (pages 7-8), the Examiner acknowledges that the effects suggested by Hosokawa '826 are gel stability, and not the stability of a resin composition. Applicants respectfully submit that such an assertion is improper as one of ordinary skill in the art as the Examiner is taking the composition of Obayashi '989, the primary reference, based on the disclosure of Hosokawa '826, but at the same time would have to dismiss this difference in the state (e.g., before swelling) as well as the those substances exhibiting the effects.

Finally, the Examiner dismisses Applicants' explanation of unexpected results by referring to how the references can be combined for a separate reason. However, this is not

giving proper consideration of the unexpected results shown in the present specification. As held in *Graham* as well as other case law, Applicants can rebut a rejection for obviousness by submitting a showing of unexpected results. The unexpected results should be considered.

As explained, the discoloration resistance of the present invention by using the aminocarboxylic acid-based metal chelating agent is clearly shown in the Examples of the present specification (see starting on page 13). As seen in Tables 1-2 at pages 20-21, the water-absorbent resin composition of Comparative Example 3 (which does not contain an aminocarboxylic acid-based metal chelating agent) achieves very low discoloration resistance, as compared to the water-absorbent resin composition of, e.g., Inventive Example 1. Comparative Example 3 achieves a discoloration value of “C” (Table 2), wherein the criteria is described at pages 18-19 of the specification. Besides Comparative Example 3 lacking the aminocarboxylic acid-based metal chelating agent component, Applicants note that the other ingredients and amounts thereof are consistent between Inventive Example 1 and Comparative Example 3.

Further, “[o]ne way for a patent applicant to rebut a *prima facie* case of obviousness is to make a showing of ‘unexpected results,’ *i.e.*, to show that the claimed invention exhibits some superior property or advantage that a person of ordinary skill in the relevant art would have found surprising or unexpected. The basic principle behind this rule is straightforward -- that which would have been surprising to a person of ordinary skill in a particular art would not have been obvious. The principle applies most often to the less predictable fields, such as chemistry, where minor changes in a product or process may yield substantially different results.” *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995). The “*Response to Arguments*” section does not give proper consideration to these results. Applicants note that the rejections

under § 103(a) are overcome because evidence of unexpected results is in the present specification and it is improper to not consider such evidence of patentability for the present invention. *See In re Soni*, 54 F.3d 746, 34 U.S.P.Q.2d 1684 (Fed. Cir. 1995) (error not to consider evidence in the specification).

Based on the above, reconsideration and withdrawal of all rejections are respectfully requested.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/561,450

Art Unit 1796

After Final Office Action of February 17, 2009

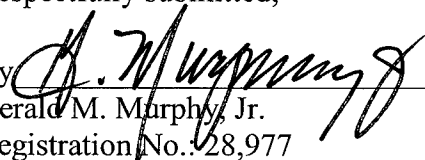
Docket No.: 1422-0702PUS1

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: May 18, 2009

Respectfully submitted,

By


Gerald M. Murphy, Jr.

Registration No.: 28,977

BIRCH, STEWART, KOLASCH & BIRCH, LLP

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000